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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/721,560	11/25/2003	Nicholas Frank Ciminello	END920030109US1	5820
49389	7590	03/09/2007	EXAMINER	
PASTEL LAW FIRM 8 PERRY LANE ITHACA, NY 14850			PICKETT, JOHN G	
			ART UNIT	PAPER NUMBER
			3728	
SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE		
3 MONTHS	03/09/2007	PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/721,560	CIMINELLO ET AL.	
	Examiner	Art Unit	
	Gregory Pickett	3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 07 December 2006.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-9 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 25 November 2003 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action acknowledges the applicant's amendment filed 7 December 2006. Claims 1-9 are pending in the application.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 103

3. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Prior Art Figures 1, 2, and 6 of the instant Application (hereinafter PA1, 2, & 6) in view of Lyons (US 5,829,591).

Claim 1: PA1, 2, & 6 discloses a reticle SMIF pod with a dome **10** having a plurality of spring-loaded latchkeys **12**, and a cassette **14'** having a plurality of primary engagement locations **18'** that are intended to receive the plurality of latchkeys. PA1, 2, & 6 discloses the claimed invention except for the secondary engagement locations.

Lyons teaches a receptacle **10** with a base **12** and a cover **14**, wherein the base has a plurality of primary engagement locations (slots **18** closest to bottom **16**) and a plurality of secondary engagement locations (slots **18** located above those closest to bottom **16**) for the purpose of variable volume (see for example Col. 2, lines 27-32). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the pod of PA1, 2, & 6 with additional engagement locations as taught by Lyons in order to vary the volume of the pod. It has been held that the provision of

adjustability, where needed, involves only routine skill in the art. *In re Stevens*, 101 USPQ 284 (CCPA 1954).

As to claims 2 and 3: At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to provide the secondary slots in the claimed numbers because applicant has not disclosed that the specific numbers provide an advantage, are used for a particular purpose, or solve a stated problem. One of ordinary skill in the art, furthermore, would have expected applicant's invention to perform equally well with any number of secondary engagement locations because applicant readily admits as such (see specification at paragraph [021]).

Therefore, it would have been an obvious matter of design choice to modify the pod of PA1, 2, & 6-Lyons with the claimed number of secondary engagement locations to obtain the invention as specified in claims 2 and 3.

Claim 4: PA1, 2, & 6-Lyons, as applied to claim 1 above, discloses the claimed invention.

Claims 5 and 6: PA1, 2, & 6-Lyons, as applied to claims 2 and 3 above, discloses the claimed invention

Claim 7: The active method step claimed is the provision of structure, namely a plurality of secondary latchkey receivers. PA1, 2, & 6-Lyons, as applied to claim 1 above, discloses the claimed method step upon presentation. As the latchkey of PA1, 2, & 6-Lyons is spring loaded, the pod is inherently capable of preventing the cassette

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from completely disengaging from the dome if the latchkeys fail to engage the primary latchkey receivers.

Claims 8 and 9: No active method steps are presented. It has been held that to be entitled to weight in method claims, the recited structure limitations therein must affect the method in a manipulative sense, and not to amount to the mere claiming of a use of a particular structure. *Ex parte Pfeiffer*, 1962 C.D. 408 (1951). Accordingly, PA1, 2, & 6-Lyons, as applied to claims 2 and 3 above, discloses the claimed invention

Response to Arguments

4. Applicant's arguments filed 7 December 2006 have been fully considered but they are not persuasive.

5. Applicant's argument that there is no motivation in the instant specification for modifying the volume of the pod is irrelevant. Lyons teaches a receptacle with a plurality of primary engagement locations and a plurality of secondary engagement locations for the purpose of variable volume. The motivation for modifying a primary reference need not come from the primary reference itself, but may come from a secondary reference. *In re Laskowski*, 10 USPQ2d 1397 (Fed. Cir. 1989). The law does not require that references be combined for the reasons contemplated by the inventor as long as some motivation or suggestion to combine them is provided by the prior art taken as a whole. *In re Beattie*, 974 F.2d 1309, 1312, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992). The reason or motivation to modify the reference may often suggest

what the inventor has done, but for a different purpose or to solve a different problem. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant. See, e.g., *In re Kahn*, 441 F.3d 977, 987, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). As to the function, all benefits of claimed invention need not be explicitly disclosed in reference to render claim unpatentable under 35 USC 103. See *In re Dillon*, 919 F.2d 688, 16 USPQ2d 1897 (Fed. Cir. 1990). Since the claimed subject matter would have been obvious from the references, it is immaterial that the references do not state the problem or advantage ascribed by applicant. See *In re Wiseman*, 201 USPQ 658.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory Pickett whose telephone number is 571-272-4560. The examiner can normally be reached on Mon-Fri, 11:30 AM - 8:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Greg Pickett
Examiner
5 March 2007


Mickey Yu
Supervisory Patent Examiner
Group 3700